



06-21-04

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Express Mail Label No. EU746729727US

Attorney Docket No. 63049.000092

Attorney Customer No. 27682

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

Ronald D. BLUM et al.

Serial No.: 10/627,828

Filing Date: July 25, 2003

Group Art Unit: 2873

Examiner: Jordan M. Schwartz

Confirmation No: 3770

Title: SYSTEM, APPARATUS AND METHOD FOR CORRECTING VISION
USING AN ELECTRO-ACTIVE LENS

RESPONSE TRANSMITTAL LETTER

MAIL STOP AMENDMENT

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

Enclosed is a Response to Restriction Requirement Under 35 U.S.C. § 121 in connection with the Office Action dated May 25, 2004 for the above-identified patent application.

☐ A petition for Extension of Time is also enclosed.

☐ Also enclosed is _____.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R.

§ 1.129(a) is also enclosed.

☒ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below:



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CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	93	Minus 93 =		x \$18.00 =	
Independent Claims	16	Minus 16 =		x \$86.00 =	
If Amendment adds multiple dependent claims, add \$260.00					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					

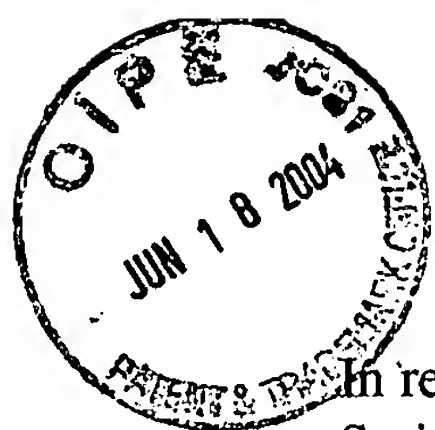
- ☐ Charge \$_____ to Deposit Account No. 08-3436 for the fee due.
- ☐ Check No. _____ in the amount of \$_____ is enclosed for the fee due.
- ☒ An Express Mail Certificate Under 37 C.F.R. §1.10.
- ☒ Self-addressed stamped postcard.
- ☒ The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §1.16, 1.17 and 1.21 that may be required by this paper to Deposit Account No. 08-3436.

Date: June 18, 2004

Respectfully submitted,

By:  #50,311

Shawn K. Leppo
Registration No. 50,311



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Page 3 of 3

Please direct all correspondence to:

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(804) 788-7216 telephone number
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RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. § 121

Sir:

The present communication is responsive to an Office Action dated May 25, 2004 in the above-captioned application (the "Application") requiring a restriction of the claims submitted for examination.

Claims 1-93 are currently pending in the Application. In the Office Action, it was asserted that the Application contains claims which are directed to four distinct inventions.

As a result, the Examiner issued a Restriction Requirement requiring the election of a single group of claims for prosecution. The claims, as grouped by the Examiner, appear as follows:

Group I: Claims 1-41, drawn to an optical system for refracting light, classified in class 351, subclass 168.

Group II: Claims 42-60 and 64, drawn to a spectacle lens, classified in class 351, subclass 159.

Group III: Claims 61-63, drawn to a method for producing a spectacle lens,
classified in class 351, subclass 177.

Group IV: Claims 65-93, drawn to an electro-active lens,
classified in class 359, subclass 642.

In the event that Applicants elect the claims of Group IV, the Examiner has required the Applicants to select a single disclosed species for examination. The Examiner has asserted that Group IV contains claims directed to two patentably distinct species: Group IVa, claims 65-83, directed to a species of electro-active lens comprising electrodes which need not be in a grid or array and which can be of any thickness and Group IVb, claims 84-93, directed to a species of electro-active lens with an electro-active material having a substantially constant thickness and with electrodes in either a grid or array.

Applicants respectfully traverse the restriction requirement.

Applicants submit that the claims of the designated groups have not necessarily acquired a separate status in the art for examination purposes, notwithstanding possible different art classifications which may have been artificially assigned thereto in the Patent Office. Art very relevant to the patentability of one group might logically be found in the art classes assigned to one of all of the other claim groups. The classification cited in support of the election requirement is merely used for cataloging purposes and is not conclusive of the propriety of such a requirement.

Furthermore, under the patent statute, 35 U.S.C. § 121, an application may be properly required to be restricted to one of two or more claimed inventions, only if they are able to support separate patents and they are either independent or distinct. 37 C.F.R. § 1.141; MPEP

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803. However, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions. MPEP 803. Applicants respectfully submit that given the overlapping subject matter of the claims of Group IV, all of claims 65-93 could be examined together with little additional burden on the Examiner.

Notwithstanding the above, in order to comply with the Restriction Requirement, Applicant elects with traverse, the claims of Group IV for further prosecution. In making this election, Applicants further elect to prosecute the species identified by the Examiner as Group IVb, claims 84-93. Applicants request that the remaining claims be held in abeyance under provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

Date: June 18, 2004

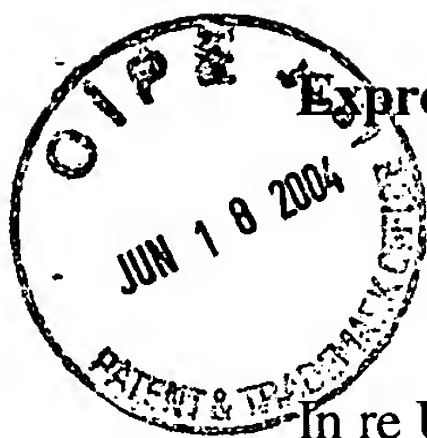
Respectfully submitted,

By:  # 50,311

Shawn K. Leppo
Registration No. 50,311

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CERTIFICATE OF EXPRESS MAILING UNDER 37 C.F.R. §1.10

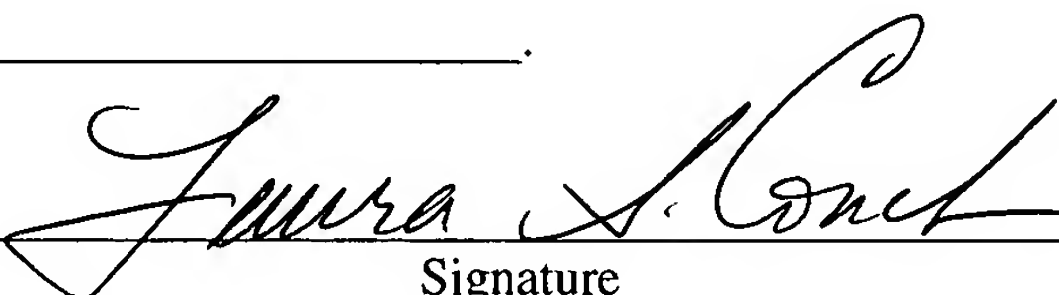
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Sir:

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on June 18, 2004
Date



Signature
Laura A. Couch

Typed or printed name of person signing Certificate

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Documents being submitted with this Certificate of Express Mailing include:

- 1) Response Transmittal Letter
- 2) Response to Restriction Requirement Under 35 U.S.C. § 121
- 3) Self addressed stamped return postcard

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